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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 780,758	02 08 2001	Elaine Unemori	CONN-003CON	6616

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BOZICEVIC, FIELD & FRANCIS LLP  
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EXAMINER

KAUFMAN, CLAIRE M

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 03 19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

09/780.758

Applicant(s)

UNEMORI ELAINE

**Office Action Summary**

Examiner

Claire M. Kaufman

Art Unit

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-27 is/are allowed.
- 6) ☒ Claim(s) 28-32 and 34 is/are rejected.
- 7) ☒ Claim(s) 33, 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other

### **DETAILED ACTION**

The amendment filed 12/17/02 has been entered.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on December 17, 2002, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,211,147 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Response to Arguments***

The rejection of claims 23-27 under Double Patenting is withdrawn in view of the proper Terminal Disclaimer.

The rejection of claims 23, 24 and 26 under 35 USC 102(b) is withdrawn in view of the amendment to the claims. Note that other claims remain rejected as discussed below.

The rejection of claims 23-27 and 28-35 under 35 USC 103 is withdrawn in view of the amendment to the claims and Applicant's arguments.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

Claims 28-32 and 34 remain rejected under 35 U.S.C. 102(b) as being anticipated by Cronin et al. (US Patent 5,166,191) in light of Applicant's admission, as set forth in the previous Office action (paper # 4, pages 3-4).

Applicant argues "Cronin neither discloses nor suggests the instant methods [for inducing secretions of VEGF] as claimed..." And, "Without the knowledge provided in the instant specification, those skilled in the art from reading Cronin, would not have known that relaxin promotes angiogenesis and induces VEGF." The argument has been fully considered, but is not persuasive. The method steps of Cronin et al. anticipate the method steps of the instant invention for dosage, duration and, therefore, inherently for outcome. One would not have had to have prior knowledge of the effects of relaxin on VEGF to have the method of Cronin et al. induce

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VEGF secretion. The VEGF secretion would happen regardless of knowledge since Applicant has shown that the dose and exposure time used by Cronin would have that desired effect (see page 10, line 37, to page 11, line 6, of the instant specification). To argue (bottom of p. 4) that, "The Office Action has provided no basis in fact and/or technical reasoning to support a determination that induction of VEGF necessarily flows from the teachings of Cronin", is to refute Applicant's own findings discussed above.

Applicant argues that every feature of a claim must be recited by the prior art reference or the missing matter must be filled with recourse to extrinsic evidence in order for the reference to serve as an anticipatory reference by inherency, such that the missing matter is necessarily present in the thing described by the reference and that it would be so recognized by the person of ordinary skill in the art at the time the invention was made. The argument has been fully considered, but is not persuasive. While the argument by Applicant is factually correct, the Cronin et al. patent relied upon for anticipation of the claimed invention provides extrinsic evidence that the claimed functional feature is necessarily present. By Cronin et al. meeting the criteria of dosage and duration shown by Applicant to induce VEGF secretion, the method of Cronin must necessarily function as the claimed method does. All claim limitations are explicitly or necessarily implicitly met. The artisan or ordinary skill would have clearly recognized that the teachings of Cronin et al. would produce the result of VEGF secretion because the method is the same as that used by Applicant as discussed in the preceding paragraph. Cronin et al. does not teach away from VEGF secretion. One of ordinary skill in the art would have reasonably expected the method of Cronin et al. to function both as literally described by Cronin and with all inherent activities whether or not spelled out by the reference. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 195 USPQ 430, 433 (CCPA 1977).

### *Conclusion*

Claims 23-27 are allowed.

Claims 33 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Thursday from 8:30AM to 12:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at (703) 308-6564.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. **NOTE:** If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office. **Please** advise the examiner at the telephone number above before facsimile transmission.

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*Elizabeth C. Hammer*

Claire M. Kaufman, Ph.D.

*[Signature]*  
Patent Examiner, Art Unit 1646

March 18, 2003